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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,222	02/09/2001	Andrew M. Schwarzbauer	38916/24384	5359

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 09/780,222	Applicant(s) SCHWARZBAUER ET AL.	
	Examiner Mark T Henderson	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 16-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 15 is/are rejected.
- 7) ☒ Claim(s) 10-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 3722

## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. The drawings have been amended to overcome the previous drawing objections.

Art Unit: 3722

***Election/Restriction***

2. This application contains claims 16-23 drawn to an invention nonelected without traverse in Paper No. 9. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Double Patenting***

3. Claim 1, 3-7, 8 and 15 are finally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 6, 8 and 9 of U.S. Patent No. 6352,287 (Casagrande). Although the conflicting claims are not identical, they are not patentably distinct from each other because Casagrande discloses in the claims the limitations of a form having a base paper layer (paper layer) having top and bottom surfaces; a primary film layer (transparent lamina) a breakaway layer (release agent layer ) coated on top of the primary layer (transparent lamina); an adhesive layer; die cuts extending through the top and bottom surfaces of a business form layer (paper layer), adhesive layer and through the breakaway layer; wherein the breakaway layer has a greater affinity for the adhesive layer than the primary film layer; wherein the bottom surface of the release layer and top and bottom surfaces of the base paper layer are

Art Unit: 3722

capable of accepting print; and wherein the breakaway layer is composed of translucent material, and made of acrylic urethane, and varies in thickness (between 0.1 and 1 mil).

However, Casagrande does not disclose: a breakaway layer having release levels that vary in a predetermined pattern; a lower release level adjacent the periphery of the primary film layer; and composed of a material having a thickness that varies at different points along the primary film layer.

In regards to **Claims 1 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the various release levels of the breakaway layer at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to **Claim 6**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the breakaway layer of any desirable material that varies in thickness at different points, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claim 8**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the die-cuts at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Art Unit: 3722

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-9 and 15 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (6,328,340).

Fischer discloses in Fig. 3a and 3b, a form with an integrated card comprising: a primary film (21) having top and bottom surfaces and a periphery; a breakaway layer (22) directly and removably bonded to the primary film layer, constructed of translucent urethane acrylic, and capable of accepting printed indicia (Col. 5, lines 20-25); a secondary film layer (23) adhesively bonded to the breakaway layer; a die-cuts (31); and a base paper layer (1) adhesively bonded (adhesive 24) to the secondary film layer; and an information card consisting of the die-cut base paper (1), secondary film layer (28), and the breakaway layer (22); wherein the breakaway layer is removably bonded to the primary film layer and permanently bonded to the secondary film layer (28, through adhesive 24).

Art Unit: 3722

However, Fischer does not disclose: composed of a material having a thickness that varies at different points along the primary film layer: a breakaway layer having release levels that vary in a predetermined pattern; a lower release level adjacent the periphery of the primary film layer; .

In regards to **Claims 1 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the various release levels of the breakaway layer at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to **Claim 6**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the breakaway layer of any desirable material that varies in thickness at different points, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claim 8**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the die-cuts at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Art Unit: 3722

***Allowable Subject Matter***

5. Claims 10-14 are finally objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

6. Applicant's arguments filed on October 7, 2002 have been fully considered but they are not persuasive.

In regards to applicant's argument that the prior art (Fischer) teaches away from applicant's invention in that the prior art employs layers on both sides of the form paper sheet, the examiner submits that Fig. 3a and 3b disclose the more simplified form in which layer are placed on one side of the form.



Art Unit: 3722

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3722

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

December 7, 2002



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